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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/156,886
Filing Date: September 18, 1998
Appellant(s): MUSSIG, BERNHARD

Kurt Briscoe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 20, 2006 appealing from the Office action mailed March 18, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(A) Listing of the Prior Art of Record

EP 661364	Koga et al.	7-1995
5,643,676	Dobashi et al.	7-1997

(B) Brief Description of the Prior Art of Record

Koga et al. disclose a self-adhesive protective film for temporarily protecting the surface of a metal or coated metal substrate from corrosion, dust deposition, or damage during transport or storage that has strong initial tack but is later easily removed. Koga et al. teach the film comprises a backing film and an adhesive layer wherein the adhesive layer comprises a copolymer of at least two different α-olefins having 2 to 12 carbon atoms, the α-olefin copolymer content is 15-70 mol% of any single α-olefin, and at least one further comonomer including a diene.

Dobashi et al. disclose self-adhesive protective films used to temporarily protect painted automobile parts, i.e. coated metal substrates, during transport or storage comprising a backing film and an adhesive layer.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 37-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koga et al. (EP 661364) in view of Dobashi et al. (U.S. Patent 5,643,676).

Koga et al. disclose a self-adhesive protective film for temporarily protecting the surface of a substrate (e.g. a metal or coated metal substrate) from corrosion, dust deposition, or damage during transport or storage that has strong initial tack but is later easily removed. Koga et al.

teach the film comprises a co-extruded backing film and adhesive layer. Koga et al. teach the backing film comprises a multilayer structure wherein the base layer of the film is formed of α-olefins and the layer contacting the adhesive layer is formed of α-olefins such as propylene to form a strong bond with the adhesive layer, i.e. it acts as an adhesion promoting layer. Koga et al. teach the adhesive layer comprises a copolymer of at least two different α-olefins having 2 to 12 carbon atoms, the α-olefin copolymer content is 15-70 mol% of any single α-olefin, and at least one further diene comonomer. Koga et al. teach the diene comonomers comprise up to 50% by weight of the adhesive layer, and the diene comonomers are included for advantages such as lowering the glass transition of the adhesive layer, improving the low temperature adhesion characteristics, and providing an adjustable initial tack. Koga et al. teach the adhesive layer further comprises standard additives including polar comonomers and crosslinking agents. Koga et al. teach the protective film has a bond strength to steel of at least 0.7 N/cm (Page 2, lines 12-56 and Page 3, lines 30-36, 41-42, 45-50, 54-57 and Page 4, lines 19-25 and 30-50 and Page 5, lines 15-58 and Page 6, lines 1, 6-7, and 18-21). Koga et al. are silent as to specifically reciting the use of the protective film for protecting the paint finish of a vehicle or vehicle component, it being noted Koga et al. do not provide any specific uses other than for temporarily protecting a metal or coated metal substrate from corrosion, dust deposition, or damage during transport or storage. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the protective film taught by Koga et al. to protect the paint finish of a vehicle or vehicle component from corrosion, dust deposition, or damage during transport or storage as it was well known in the art to use protective films of this type for this purpose as shown for example by Dobashi et al.

Regarding claims 37, 40, 42, 44, 47-49, 52, and 53, Koga et al. do not specifically recite the specific Mooney viscosity of the adhesive layer. However, the adhesive composition taught by Koga et al. is the same as that claimed and disclosed in appellants specification such that one of ordinary skill in the art would readily expect both compositions to have the same Mooney viscosity particularly in view of the wide range claimed, i.e. less than 50. Furthermore, as noted above Koga et al. disclose an adhesive composition (including a range of additives) that is not particularly limited such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine specific properties of the adhesive, e.g. viscosity, adhesive force, etc., as a function of the specific composition used, e.g. amount of copolymer, amount diene, amount of polar comonomers, etc., as doing so would have required nothing more than ordinary skill and routine experimentation.

Regarding claims 41, 45, 46, and 50, Koga et al. are silent as to the backing film including light stabilizers. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the backing film taught by Koga et al. light stabilizers as it was well known in the art to include light stabilizers in the backing film to improve its weatherability as shown for example by Dobashi et al.

Dobashi et al. disclose self-adhesive protective films used to temporarily protect painted automobile parts, i.e. coated metal substrates such as a trunk, roof, bonnet, etc., during transport or storage comprising a backing film and an adhesive layer based on α-olefins. Dobashi et al. teach the backing film includes light stabilizers (such as HALS in an amount of 0.1 to 5% by weight) to give the protective film a UV permeability in the range from 190 to 370 nm of less than 1%, i.e. the light stabilizers improve the weatherability of the protective film (Column 1,

lines 5-8 and Column 2, lines 19-25 and 59-65 and Column 3, lines 27-33 and Column 4, lines 1-10 and Column 5, lines 57-59 and Column 7, lines 5-12 and Column 8, lines 32-60 and Column 11, lines 11-18).

(10) Response to Argument

> Appellant argues, "The Examiner has not, in fact, shown the film of Koga to be so like those of Dobashi that a person having ordinary skill in the art would have been motivated to use Koga's film to protect paint finishes with a reasonable expectation of success. The metal surfaces of Koga would have been regarded by those skilled in the art as being so dissimilar to painted surfaces that such persons would not have had a reasonable expectation that the use of Koga's films to protect a painted surface should be successful. In the absence of such reasonable expectation of success, no *prima facie* case of obviousness is made out.".

Koga et al. disclose a self-adhesive protective film for temporarily protecting the surface of a substrate (e.g. a metal or coated metal substrate) from corrosion, dust deposition, or damage during transport or storage that has strong initial tack but is later easily removed (See in particular **Page 2, lines 11-28** Koga et al.). Dobashi et al. disclose self-adhesive protective films are used to temporarily protect automobile parts and specifically painted automobile parts, i.e. metal or coated metal substrates, during transport or storage comprising a backing film and an adhesive layer (See in particular **Column 1, lines 5-8 and 10-21 and Column 2, lines 19-25** Dobashi et al.). Thus, one of ordinary skill would have readily appreciated, i.e. had a reasonable expectation of success, using the self-adhesive protective film taught by Koga et al. to temporarily protect automobile parts including painted automobile parts which are metal or metal coated substrates, i.e. painted automobile parts and metal or coated metal substrates are not dissimilar substrates, from corrosion, dust deposition, or damage during transport or storage in view of Dobashi et al.

> Appellant further argues, "Those same results, which are summarized below, show that ***not including a diene leads to defects in the paint.***".

This statement is incorrect. Appellants results show that an adhesive including a diene component produces a protective film that is removed from a substrate without defect. However, the results do not show the ability to remove the protective film without defect is a result of the diene component, as appellants have not compared the closest prior art. For example, each inventive example consists of propene, ethylene, and 5-ethylidene-2-norbornene. However, none of the comparison examples consists only of propene and ethylene. Thus, there is no clear showing that the protective films having an adhesive consisting of propene, ethylene, and 5-ethylidene-2-norbornene can be removed without defect from a substrate due to the inclusion of the 5-ethylidene-2-norbornene.

> Appellant further argues, "It should be clear from the data that when the olefins are manipulated *within* the claimed ranges and combined with a diene, then the removal of the adhesive from fresh paint does not lead to defects. On the other hand, when the olefin are manipulated *outside* the claimed range and do not include the diene, then there are always problems encountered in removing the adhesive from fresh paint.".

It is not clear. As noted above, the comparison examples are not the closest prior art. Every inventive example consists of propene, ethylene, and 5-ethylidene-2-norbornene. None of the comparison examples consist of propene and ethylene. Thus, appellants have not established any criticality to including a diene nor have appellants established any criticality for the range of not more than 75 mol-% of any singe α-olefin.

> Appellant further argues, "Whether Koga teach an advantage in including Appellant's dienes, the fact is that Koga teaches they are only optional ingredients, and, therefore, not essential. Thus, Koga teaches the dienes are present at 0-50% by weight, 0% meaning the adhesive does not contain any dienes at all. In stark contrast to this, Appellant has demonstrated that the inclusion of the diene is critical for protecting paint finishes. There is absolutely nothing in the combination of Koga and Dobashi that suggests this result. Consequently, the data in the specification are evidence of a surprising and unexpected result, which is, therefore, objective proof of nonobviousness.".

Koga et al. ***expressly*** teaches, "If the SEBS (D) is to be used as the sub-component in the adhesive layer in the film of the invention, its relative proportion to typically 0-50 wt%, preferably 0-45 wt%." (Page 5, lines 23-24). Koga et al. ***expressly*** teaches, "If the SIS (E) is to be used as the sub-component in the adhesive layer in the film of the invention, its relative portion is typically 0-50 wt%, preferably 0-30 wt%." (Page 5, lines 33-34). Thus, Koga et al. expressly teach the adhesive composition includes a diene, i.e. it is not a question of obviousness. Appellants results even if they were to show an unexpected result would not overcome the express teaching in Koga et al. to include a diene component.

In summary, the use of the self-adhesive protective film taught by Koga et al. for temporarily protecting the surface of automobile parts and specifically painted automobile parts, i.e. metal or coated metal substrates, from corrosion, dust deposition, or damage during transport or storage would have been obvious in view of Dobashi et al. showing the use of such films for this purpose wherein Koga et al. expressly teach the adhesive on the film includes a diene.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John L. Goff

Conferees:

Richard Crispino

Steve Griffin